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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/364,731	07/30/99	KATZ R	244/165

EXAMINER	
WOO, S	
ART UNIT	**PAPER NUMBER**
2643	5

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LYON & LYON LLP
DAVID B MURPHY
633 WEST FIFTH STREET
47TH FLOOR
LOS ANGELES CA 90071

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
*U.S. GPO: 2000-473-000/44602

1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/364,731	Katz
Examiner	**Group Art Unit**
Stella Woo	2643

☒ Responsive to communication(s) filed on *Nov 17, 2000*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *29-48* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *29-48* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 29-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention for the same reasons given in the last Office action and repeated below.

Claims 29-37 recite a "telephone system of a type controllable by travel cards" and claim 38 recites a "method of handling telephone calls by use of travel cards." However, applicant's specification contains no teaching or suggestion of using "travel cards," which play the central role in the system of Marshall. A telephone travel card is issued by a telephone company to enable a caller to place long distance calls over any phone and to charge the call to the account of the accountholder. The travel card authorization takes place at the telephone switching facility such that the call is not completed through the telephone network unless certain conditions are met. In contrast, applicant's specification describes the use of a credit card to authorize a transaction, such as mail order transaction or lottery participation, which takes place over an already completed telephone connection. A travel card is used to authorize telephone call completion between a caller and a desired second party. The credit card or lottery ticket of the applicant is used to authorize a mail order transaction or participation in a lottery; calls are

completed to applicant's telephone-interface system without any prior qualification based on the credit card or lottery identification data. Therefore, applicant's credit card or lottery ticket cannot be considered as a "travel card" which carries out a specific function in the telephony art.

Claims 29-37, 39-47 recite a "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing" as recited in claims 29-37, 39-47 since in applicant's system, the call is completed through the switching facilities (communication facility C, ACD, switch 21) irrespective of the caller's standing.

Claims 38 and 48 recite "preventing connection of telephone calls if validation determines the call is not made by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled

by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the step of "preventing connection of telephone calls if validation determines the call is not made by a caller in good standing."

Applicant's disclosure fails to provide support for the voice response device which is able to "make a call through the telephone system," "prevent a caller using a travel card to make a call through the telephone system," "leave a message for at least one subsequent caller using a travel card to make a call through the telephone system," and "permit a caller using a travel card to make a call through the telephone system to be automatically rerouted to a call number supplied to the system by a travel card customer" as recited in claims 30 and 40.

Applicant's disclosure fails to provide support for performing a "repeated failed attempts determination" and "preventing repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time" as recited in claims 31 and 41. Applicant's system provides for a use-rate calculator for determining and limiting the number of successful uses by a caller, not the number of failed attempts.

Applicant's disclosure does not provide support for "a data storage server means...capable of access by travel card customers of the telephone system to provide current billing information to travel card customers" as recited in claims 32 and 42 or "a voice response means being...capable of providing an oral report of current account status to travel card users" as recited in claims 33 and 43.

3. Claims 39-48 of this application is asserted by applicant to correspond to claim(s) of U.S. Patent No. 5,790,636.

The examiner does not consider these claims to be directed to the same invention as that of U.S. Patent No. 5,790,636 because it does not contain all the material limitations of the patent claim as required by 35 USC 135 (b), namely, the use of a travel card for controlling the telephone system. Accordingly, an interference cannot be initiated based upon these claims.

4. Claims 29-48 of this application has been copied by the applicant from U. S. Patent No. 5,790,636. This claim is not patentable to the applicant because they are not supported by applicant's original disclosure.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

5. Applicant's arguments filed November 17, 2000 have been fully considered but they are not persuasive.

Applicant argues that "it is not important whether a card is called a 'travel' card or by any other name...as long as use of the card is carried out in a similar way." The examiner contends that the card in applicant's disclosure is not used in the same way as a travel card and, therefore, cannot be considered as a travel card as recited in the claims. The card in applicant's system is used to participate in a lottery or mail-order operation, the authorization (based on call data including ANI and a personal identification number as recited in independent claims 29, 38, 39, 48) taking place after the caller has been connected through the telephone network with a voice generator at the processing system P1 (page 18, line 31 - page 22, line 29). In contradistinction, a travel card is used by a caller to place a call from any telephone to a second party, the authorization taking place at the telephone switching station before the call is completed through the telephone network.

Applicant refers to page 13 of his specification as providing support for a "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller of good standing." Claims 29-48 require that the switching computer means determine whether or not a caller is in good standing based on the processing of call data which includes both automatic number identification and a personal identification number. Page 13 of applicant's specification describes the testing of the caller's telephone number only, not telephone number plus personal identfication number as required by the claims. Moreover, applicant's system does not disallow completion of a call through the switching station. Rather, applicant's system disallows participation by a caller in a health-related

statistical analysis, lottery or mail-order operation. In applicant's system, a caller places a call which is completed through the public telephone network to a voice generator in applicant's processing system P1 with which the caller interacts to provide a personal identification number (page 18, line 31 - page 22, line 29). It is after the call is connected with applicant's processing system that qualification takes place. Therefore, applicant's system does not teach a "switching computer means capable of disallowing completion of a call through the switching station if determined from processing of call data and additional parameter by the switching computer that the call is not placed in good standing."

Regarding the limitations of claims 30 and 40 which recite a voice response device which is able to "make a call through the telephone system," "prevent a caller using a travel card to make a call through the telephone system," "leave a message for at least one subsequent caller using a travel card to make a call through the telephone system," and "permit a caller using a travel card to make a call through the telephone system to be automatically rerouted to a call number supplied to the system by a travel card customer," applicant argues that his interface 20 is "capable of performing the above-stated functions." However, applicant does not point out where in his specification these functions are provided for his specification. The examiner maintains that the specification finds no support for the above-stated functions.

Regarding the limitations of claims 31 and 41 which recite performing a "repeated failed attempts determination" and "preventing repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification

numbers with a predetermined period of time," applicant points to page 13 of his specification where his system determines if the caller has entered a proper telephone number or not. However, the personal identification number of dependent claims 31 and 41 is not the caller's telephone number (note independent claims 29 and 39 which state that call data includes automatic number identification and a personal identification number). Moreover, by definition, a personal identification number is a number specific to an individual, not a telephone station.

Regarding the limitations of claims 32 and 42 which recite "a data storage server means...capable of access by travel card customers of the telephone system to provide current billing information to travel card customers" and the limitations of claims 33 and 43 which recite "a voice response means being...capable of providing an oral report of current account status to travel card users," applicant points to page 40, lines 28-33. However, this section merely describes a voice generator informing a game participant whether or not his answers are correct. It does not provide support for any of the above-stated functions.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306 or (703) 308-6296;

(for formal communications, please mark "EXPEDITED PROCEDURE";

and for informal or draft communications, please label "PROPOSED" or "DRAFT").

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached from 6:00 a.m. until 2:30 p.m., Monday through Friday.

February 10, 2001

STELLA WOO
PRIMARY EXAMINER